

d.) **Remarks**

Claims 23-103 are presently pending. No amendments or new claims are introduced with this Response.

Remarks regarding 35 U.S.C. § 102(e)

Claims 23, 24, 26, 29-44, 46-49, 52, 76, 77, 79, 82-87, 89, and 91-101 stand rejected, under 35 U.S.C. § 102(e), as allegedly anticipated by U.S. Patent No. 6,426,134 ("Lavin"), in view of alleged evidence given in U.S. Patent No. 6,299,812 ("Newman"). Applicants respectfully traverses the rejection.

It is well established that only a single reference may anticipate a claim. Thus, this rejection is interpreted as being based solely on Lavin. Newman is not considered to play any part of this rejection. Applicants also respectfully note that Newman is not prior art to this application and, thus, cannot be properly applied against the claimed invention for any purpose.

37 C.F.R. § 1.131 recites, in part, that "[t]he effective date of a U.S. patent ... is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e)." In this connection, Lavin issued from Application No. 09/342,452, filed June 29, 1999, and takes priority from Provisional Application No. 60/091,201, filed June 30, 1998 (the Lavin Provisional). The rejection presumes that Lavin is effective as a prior art reference, under 35 U.S.C. 102(e), as of June 30, 1998, which is the filing date of the Lavin Provisional.

Applicants submit the attached Declaration, under 37 C.F.R. § 1.131, by Paul J. Glatkowski. As indicated therein, a composite having nanotubes that provide the composite with electromagnetic shielding was conceived and reduced to practice prior to June 30, 1998, and therefore prior to the filing date of the Lavin Provisional. Submission of the Declaration does not

constitute acquiescence in the statements set forth in the rejection, but is done solely to expedite the application to issuance.

Applicants respectfully note that this Declaration is nearly identical to the Declaration submitted on November 7, 2002 (executed October 28, 2002). On the November 7th Declaration, Mr. Glatkowski asserted that the indicated experiments were performed prior to November 7, 1998, the filing date of the Yacobson patent (U.S. Patent No. 6,280,677). On the instant Declaration, the inventor asserts that the indicated experiments were performed prior to June 30, 1998, the filing date of the Lavin Provisional. There are no other changes.

The Declaration includes a copy of a Test Report which shows shielding effectiveness data between 20 kHz and 1.5 GHz on PET-1.5 wt.% nanotube composite plaques. This data was normalized for a thickness of 1 mm and is shown in Table 2. The required shielding effectiveness per MIL-STD-188-125A is 100 dB. However, Table 2 demonstrates a shielding effectiveness of 182 dB at a nanotube loading level of only 1.5 wt%, thus indicating that the composite clearly offers both electromagnetic shielding and low observability.

Applicants respectfully submit that the evidence set forth in the Declaration establishes reduction to practice prior to June 30, 1998, the effective date of the Lavin Provisional. Accordingly, reconsideration and withdrawal of the rejection under § 102(e) are respectfully requested.

Conclusion

The application is in condition for allowance and the prompt issuance of a Notice of Allowance is respectfully requested. If there are any additional fees due with the filing of this Response, including any fees for an extension of time, applicants respectfully request that extension and also request that any and all fees due be charged to Deposit Account No. 03-1952.

Respectfully submitted,
Morrison & Foerster LLP

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Enclosed: Declaration

By

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